

Our Reference: AEI-177-A

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Dhiren K. Marjadi et al.  
Serial Number: 09/855,317  
Filing Date: May 15, 2001  
Examiner/Art Group Unit: Evens J. Augustin/3621  
Title: DIGITAL CONTENT LICENSING METHOD  
INVOLVING APPLICATION SERVICE PROVIDER

**REPLY BRIEF**

MAIL STOP APPEAL BRIEF-PATENTS  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

This is Appellants' Reply Brief pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed February 5, 2008.

**NEW ISSUES RAISED BY THE EXAMINER**

The Examiner's Answer raises two issues which require Appellant's rebuttal:

1. Christiano does not exclude the aspect of licenses being distributed between computers/clients and a computer that responds to commands from a client/computer (i.e. server).
2. Christiano's finder mechanism is equivalent to selecting whether to run the digital content on the customer computer network or the application service provider.

## REPLY ARGUMENT

### **Argument I**

Appellant's have argued that the license management system in Christiano is only for use in a single customer computer network and is devoid of any use in conjunction with an application service provider. Initially, the Examiner correctly recognizes that Christiano does not describe a system in which the licensed units can be distributed between a server and a user computer/network (see page 7, para. 8 of Final Office Action dated May 7, 2007). Subsequently, in the Examiner's Answer, the Examiner repeats his previous statement but also asserts for the first time that "Christiano does not exclude the aspect of licenses distributed to multiple computers/clients and that one of the computers involved would not or could not be one that responds to commands from a client/computer (i.e., server)."

It is not sufficient for an Examiner to establish a *prima facie* case of obviousness by mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art. In *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court preserves this principle as stated in *In re Kahn*, 441 F.3d 977 (C.A.Fed. 2006):

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

*KSR Intern. Co.*, 127 S.Ct. at 1741.

It is beyond argument that the Examiner has merely concluded that one of the computer systems in Christiano could be a server and has not given any objective reason for the modification. The Examiner states that "implicitly, one skilled in the art at the time of applicant's invention would deduce from Christiano that one of the computer systems could be a server and another client." The Examiner does not state any teaching, suggestion or motivation to make this implicit deduction. Accordingly, the Examiner has no basis in established law to assert that one of the computer systems Christiano could be a server responding to commands from a client.

Additionally, the Examiner states that based off this implicit deduction, it would have been obvious to combine Christiano and Wyman. The Examiner states that the motivation for combining these references is that, "according to Wyman, the distribution of units to clients and servers improves response time and increase the resilience of the system, and may be used as a method of allocating licensed units for administrative and budget/cost purposes." However, following the Examiner's reasoning, if Christiano did actually show that licenses can be distributed between a server and multiple computers, then there would be no need to introduce Wyman. Since Wyman would not be introduced to support the obviousness rejection, the Examiner would not be correct in extracting a motivation for modifying the references from Wyman. Thus, the Examiner has not proven the obviousness rejection to be valid.

## **Argument II**

Appellants have argued that since the license management system in Christiano is only for use in a single customer computer network and is devoid of any use in conjunction with an application service provider, Christiano does not teach selecting through the customer computer network one of the customer computer network and the application service provider for execution of a selected digital content. The Examiner states that a finder mechanism in Christiano, which is used for locating a computer network used for implementing or executing the software licensing system, is equivalent to selecting a network to run an application. The Examiner is incorrect. The finder mechanism in Christiano is used to locate a license server on another node which has a preconfigured address. Christiano specification, column 21, ll. 8-12; see also Fig. 12. Even though the finder mechanism is run through the client computer system, the client computer in Christiano does not select a certain node, since the location of the license server has been preset by the address. Furthermore, the license server is not a customer computer network nor is it an application service provider that can execute selected digital content as described in Appellants' invention. Thus, the Examiner has not shown how the combination of Christiano and Wyman teaches or suggests all of the claimed features of Appellant's invention as set forth in claim 1.

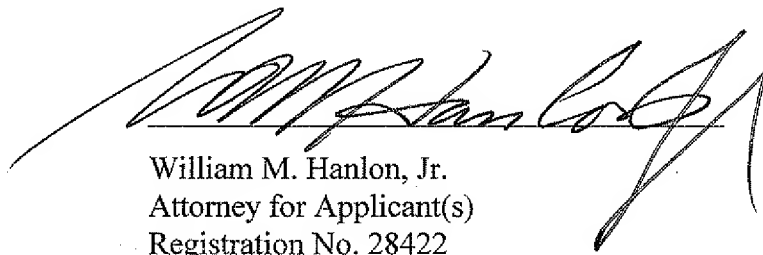
**CONCLUSION**

For the reasons set forth above, the rejections of all claims on appeal should be reversed and the application returned to the Examining Group with instruction to issue a Notice of Allowance forthwith.

Consideration of this Reply Brief is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'W. M. Hanlon, Jr.', is written over a horizontal line.

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**APPENDIX A: CLAIMS AT ISSUE ON APPEAL**

1. For use in a customer computer network having at least one node capable of executing digital content from a digital content source on the customer computer network or executing digital content from a digital content source on an application service provider, a licensing method comprising the steps of:
  - a. providing licensed units to a customer;
  - b. providing independently selectable digital content;
  - c. assigning a predetermined number of customer computer network assigned units to each independently selected digital content when the digital content is run on the customer computer network;
  - d. assigning a predetermined number of application service provider assigned units to each independently selected digital content when the digital content is run on the application service provider;
  - e. charging a number of checked out units to the customer computer network based on the digital content currently being run by the customer on the customer computer network and on the application service provider;
  - f. selecting through the customer computer network one of the customer computer network and the application service provider for execution of a selected digital content;
  - g. determining a number of available units equal to the difference between the total licensed units to the customer computer network and the total checked out units charged to the customer computer network for digital content currently being executed on the customer computer network and on the application service provider for the customer; and
  - h. determining whether a requested digital content is to be executed or denied execution on the selected one of the customer computer network and the application service provider based on the difference between the available units on the customer computer network requesting execution of the digital content and the assigned units of the selected digital content on the selected customer computer network and the application service provider.

2. The method of claim 1 further comprising the steps of:  
when the available units on the customer computer network requesting execution of a digital content are greater than or equal to an application service provider required units of the digital content requested by the customer computer network, determining when the application service provider required units of the requested digital content to be executed on the application service provider are to be charged to the available units.

3. The method of claim 1 wherein the application service provider assigned units of at least one of the digital content run on the application service provider differ from the customer computer network assigned units of the identical digital content run on the customer computer network.

4. The method of claim 1 further comprising the steps of:  
upon termination of a run of digital content on the application service provider, calculating and adding the application service provider returned units of the terminated digital content to the available units on the customer computer network.

5. The method of claim 1 further comprising the steps of:  
requesting execution of one digital content on the application service provider; and  
determining if the application service provider can immediately execute the requested digital content.

6. The method of claim 5 further comprising the steps of:  
if the application service provider cannot immediately execute the requested product, pre-charging the application service provider assigned units of the requested digital content to the requesting customer computer network; and  
queuing the requested digital content for subsequent execution on the application service provider.

7. The method of claim 1 further comprising the step of:  
determining whether to charge the application service provider required units at one of the time of the request of execution of the digital content and at the time of execution of the requested digital content on the application service provider.

8. The method of claim 7 further comprising the step of:  
when the application service provider required units are to be charged at the time of the request, and the available units are greater than or equal to the application service provider required units of the requested digital content, locking the application service provider required units and charging the application service provider required units to the available units at the requesting customer.

9. The method of claim 8 further comprising the step of:  
determining if the application service provider is able to immediately execute the requested digital content.

10. The method of claim 9 wherein:  
if the application service provider is not able to immediately execute the requested digital content, waiting for a change in the status of the available units.

11. The method of claim 9 wherein:  
when the application service provider is able to immediately execute the requested digital content; and if the available units are greater than the application service provider required units of the requested digital content and the application service provider required units of the requested digital content have been locked, executing the requested digital content.

12. The method of claim 7 wherein if the application service provider required

units are to be charged to the available units at the time of execution of the requested digital content, further comprising the step of:

at the time of execution, checking if the available units are greater than or equal to the application service provider required units and, if yes, setting the available units equal to the prior available units minus the application service provider required units and, if no, leaving the available units unchanged.



**APPENDIX B: EVIDENCE**

No evidence is appended to the Reply Brief.

**APPENDIX C: RELATED PROCEEDINGS**

There are no related proceedings.